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In re Application of
SIEWERTH, Jorg, et al.
U.S. Application No.: 10/019,524
PCT No.: PCT/DE00/01174
International Filing Date: 14 April 2000
Priority Date: 28 June 1999
Attorney's Docket No.: 112740-385
For: METHOD FOR OPERATING A MOBILE
TERMINAL AND A CORRESPONDING
MOBILE RADIO SYSTEM

COMMUNICATION
REGARDING SUBMISSION
UNDER 37 CFR 1.42

This communication is issued in response to applicant's submission on 27 December 2001 of a declaration executed on behalf of the deceased inventor, which has been treated as a submission under 37 CFR 1.42.

BACKGROUND

On 14 April 2000, applicants filed international application PCT/DE00/01174 which claimed a priority date of 28 June 1999 and which designated the United States. On 04 January 2001, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB").

On 04 September 2000, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire thirty months from the priority date, i.e., 28 December 2001.

On 27 December 2001, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee, a translation of the international application into English, and a declaration executed by the surviving co-inventor Joerg Siewerth and on behalf of the deceased co-inventor Martin Peter by Heribert Peter, identified as "Heir of Martin Peter."

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by all of the heirs of the deceased inventor, where no legal representative has been appointed or is required to be appointed by law.

37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

37 CFR 1.497(b)(2) requires that citizenship, mailing address, and residence information be provided for **both** the deceased inventor and the legal representative. The regulation expressly requires the inclusion of this information for the legal representative. As for the deceased inventor, such information is required because the legal representative must declare to all the facts which the inventor would have been required to state, and citizenship, residence and mailing address are among the facts which the inventor would have been required to set forth pursuant to 37 CFR 1.497(a) and 37 CFR 1.63.

Here, as noted above, the declaration submitted on 27 December 2001 was executed by Heribert Peter as "heir of Martin Peter." However, the declaration does not state that Heribert Peter is the sole heir of the deceased inventor, nor have applicants submitted supplemental materials showing that the listed heir is the sole heir of the deceased inventor. Accordingly, at this time the declaration cannot be accepted as having been signed by all the heirs to the deceased inventor.

In addition, the declaration does not comply with revised 37 CFR 1.497(b)(2), discussed above, in that it does not include citizenship, mailing address, and residence information for the deceased inventor (such information is provided for the heir, as also required).

Because it is not apparent whether the declaration filed on 27 December 2001 has been executed by all the heirs of the deceased inventor, and because it does not provide all the information required by 37 CFR 1.497(b)(2), the declaration cannot be accepted under 37 CFR 1.42.

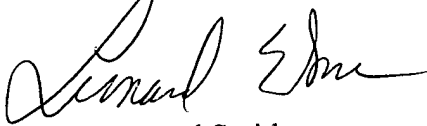
CONCLUSION

The 27 December 2001 submission under 37 CFR 1.42 is **DISMISSED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this communication to submit a proper response under 37 CFR 1.42 and 37 CFR 1.497. Failure to provide a proper and timely response will result in abandonment.

A proper response must include an acceptable declaration properly executed under 37 CFR 1.42, that is, which on its face or through supplemental materials indicates that the executing person(s) are all the heirs of the deceased inventor. In addition, the declaration must include all required information, including the citizenship, post office address, and residence information for the deceased inventor and the heirs, as discussed above.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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